UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/573,598 | 03/24/2006 | Hiroshi Ando | 059050263 | 2795 |

22852          7590          10/05/2009
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

| EXAMINER |
|---|
| KIM, ANDREW |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3714 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/05/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| | 10/573,598 | ANDO ET AL. |
| *Office Action Summary* | Examiner | Art Unit | |
| | ANDREW KIM | 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>24 March 2006</u>.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>18 May 2006</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☒ All  b)☐ Some * c)☐ None of:

  1.☒ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/24/06, 3/30/07</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____

## DETAILED ACTION

### *Specification*

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Game System with Changing Character Control.

### *Drawings*

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because fig. 4 is dark and unclear. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims seem to be wholly directed to a computer program which is not patentable subject matter. The claimed subject matter must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by**

**Square Co. LTD. (JP Pub. No. 2002-2329246).**

Claim 1. A game system which can be accessed by a plurality of players via operation

terminals, comprising a memory and a calculation processing device, wherein, a game

program is stored in said memory, said calculation processing device executes the

game program based on input data from the operation terminals, and wherein said

game system is made to implement:

means for deciding that a plurality of players have participated for game playing

(technical field);

means for establishing team composition for the plurality of players (para. 5, 6, 29, coop

mode);

means for assigning a common character to each team (para. 6);

means for determining a reference point at which operation for said character is changed over between players who belong to the same team, based on said game program (para. 33-35, shift conditions);

means for deciding whether or not said character has arrived at this reference point, from parameters of the character (para. 33-37); and

means for transferring a right of operating said character to another player when the decision is affirmative, and performing control so as to continue operation of the character, based on a signal from the operation terminal by the other player (para. 33-37).

Claim 3. The system according to claim 1, wherein said reference point is a time point which is on a time axis (para. 36).

Claim 4. The system according to claim 1, comprising means for transmitting information between a first operation terminal of a first player and a second operation terminal of a second player (para. 25, 26).

Claim 5. The system according to claim 4, wherein said means is means for implementing voice chat between said first operation terminal and said second operation terminal (para. 23).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.    Determining the scope and contents of the prior art.
2.    Ascertaining the differences between the prior art and the claims at issue.
3.    Resolving the level of ordinary skill in the pertinent art.
4.    Considering objective evidence present in the application indicating
      obviousness or nonobviousness.

**Claims 2, 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable**

**over Square Co. LTD. (JP Pub. No. 2002-2329246) in view of Chocobo Racing**

**(Oct. 31, 1999, page 2).**

Claim 2. Square substantially discloses the invention as claimed but fails to explicitly

teach that said reference point is a ground point within a three dimensional virtual space

which is defined by said game program.  Square instead seems to discloses at least a

fighting type game in which after a certain amount of hit points are reached, the control

of a character may be relinquished to another controller.  However, in analogous

reference, Chocobo discloses the popularity of racing games at the time of the invention

and thus one of ordinary skill in the art would have been motivated to combine Square

with a racing game such as Chocobo to take advantage of the racing genre that was

popular at that time. Chocobo discloses the relay race in which the reference point is a ground point within a virtual space (Square, para. 29, Chocobo, pg. 3 and 4).

Claim 6. A game program for causing a computer to function as a game device, in which a plurality of players input operation signals via respective operation means, a relay race game is executed within a game space by player characters which are operated based on the operation signals, and in which game images of the relay race game corresponding to each player are created and outputted as a game screen to display means corresponding to each player, wherein said game program includes:

Square substantially discloses the invention as claimed but fails to explicitly teach a relay racing game. Instead, Square discloses a battle-royal mode for what seems like a fighting game (para. 29). This mode is analogous to a relay race in which a team of players play against another team of players but only one player may play at one time. In analogous reference, Chocobo discloses a racing game in which there is a relay race mode in which, "A Relay Race involves a team of three racers against another team in a tag team sort of match-up. When a character reaches a specific point where another racer is waiting, that racer then takes over until the next checkpoint." One of ordinary skill in the art would have seen the benefit of modifying Square with a relay method to increase player appeal by having a team sport when all the attention is focused on one teammate at a time. Therefore, it would have been obvious to one or ordinary skill in

the art at the time of the instant invention to modify Square with the relay method to

increase player appeal.

a game setting process of, based on operation signals from the players, reading out

from a recording medium data for player characters based on selection by the players,

and acquiring information about division of the players into teams for said relay race

game, and about the order of play within each team (Square, para. 29, Chocobo, pg. 3);

a game execution process of executing a start of said relay race game between the

teams based on said team division information and the order-of-play information, and,

based on the order-of-play information, performing a process of taking a player

character of each team set as a current runner among said player characters, as a

current runner character, to be moved within the game space (Square, para. 29,

Chocobo, pg. 3, tag team match-up);

a display process of, based on the order-of-play information, moving the player

character of each team which is set as the current runner among the player characters

within said game space as the current runner character, and displaying the situation of

movement as a game screen on game screen display means of the players (Square,

para. 29, Chocobo, pg. 3, the racing game and the screenshots);

a decision process of acquiring position coordinates of said current runner character

within the game space, taking a predetermined operation change over position as a

reference point, and deciding whether or not said character is positioned within a

predetermined distance range from the reference point (Square, para. 29, Chocobo, pg. 3, when a specific point is reached another racer is waiting);

a notification process of, when decided that said current runner character is positioned within the predetermined distance range from the operation change over position, providing a display which notifies a change over of operation of said current runner character on the game screen of the player who operates the next runner character which is set as the next runner among the player characters based on the order-of-play information (Square, para. 29-33, Chocobo, pg. 3); and

an operation change over process of, when said current runner character arrives at the operation change over position, along with displaying said next runner character at the position of said current runner character, also inhibiting operation signals from the operator of said current runner character, and making effective an operation signal from the operator of the next runner character (Square, para. 29 and 51, Chocobo, pg. 3).

Claim 7. The game program according to claim 6, further comprising: a change over timing calculation process of, in said notification process, calculating timing at which operation change over is performed, based on the distance between said current runner character and said reference point; and a change over timing display process of providing a display which shows timing of operation change over on the game screen of the operator of said next runner character, based on the change over timing information calculated by the change over timing calculation process (Square, para. 29, 30, 36, 44).

Claim 8. Square substantially discloses the invention as claimed but fails to explicitly teach displaying said next runner character translucently overlapped on said current runner character and changing the characters at a certain point.  Square in view of Chocobo teach changing control of the character at a certain point in the race.  In an analogous reference, Hightower discloses a ghosting feature in which a translucent character is over lapped with the character at a certain point (abstract, 4:54-67) to increase player appeal.  Therefore, it would have been obvious to one or ordinary skill in the art at the time of the instant invention to modify Square with a translucent character to increase player appeal.

Claim 9. Square substantially discloses the invention as claimed but fails to explicitly teach  transforming one character into another character at a specific time.  Square in view of Chocobo teach changing control of the character at a certain point in the race.  However, it would have been obvious to one of ordinary skill in the art to devise a way to indicate to the players that the control of the characters has changed.  Transforming characters from one to another is well known in the art to indicate a change to the users of the system.  Therefore, one of ordinary skill in the art at the time of the invention would have found it obvious to modify Square with transforming character to indicate a change to the users of the system.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KIM whose telephone number is (571)272-1691. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
Unit 3714

10/6/2009 /A. K./
Examiner, Art Unit 3714